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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,578	07/09/2003	Seiji Kato	1003-1-01 PUS	1326

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F. JASON FAR-HADIAN, Esq.
SUITE 420
1200 PARK NEWPORT DRIVE
NEWPORT BEACH, CA 92660

EXAMINER

PARSLEY, DAVID J

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,578

Applicant(s)

KATO, SEIJI

Examiner

David J Parsley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

Detailed Action

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to because the drawing figures should be labeled 1a, 1b, 1c and 1d. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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The abstract of the disclosure is objected to because on line 1 “comprises of hard portion and soft portion” should be - -comprised of a hard portion and a soft portion- -. Further, on line 4 insert - -an- - before “elastic”. On line 5 deleted “which has elasticity”, since this is redundant in describing the elastic body. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claim 12 is objected to because of the following informalities: on line 3 “bate” should be - -bait- -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to what the composition strength for the two hard portions of the lure and/or the elastic portion quantifies. It is unclear to what the strength is which makes these components unbreakable.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,636,304 to Swenson.

Referring to claims 1 and 11, Swenson discloses a fishing lure comprising, an elongated lure body – at 10, comprising at least first and second hard components/portions – at 12, positioned at opposite ends of the elongated lure body, and a soft cover portion – at 11, wherein the soft portion houses the hard portion, and wherein the hard portion comprises at least two separate components joined by an elastic component – see the line in figure 2, for allowing the lure body to flex – see for example figures 1-2.

Referring to claims 2 and 13, Swenson discloses a fishing line attachment component – at 13, attached to one of the at least two separate components for allowing a fishing line to be connected to the lure body – at 10 – see for example figure 2.

Referring to claims 3 and 14, Swenson discloses a hook attachment component – at 13 and/or the line as seen in figure 2, attached to one of the at least two separate components for allowing a hook to be connected to the lure body – at 10 – see for example figure 2 and column 1 lines 51-52 and column 2 lines 1-20.

Referring to claim 4, Swenson discloses the lure body is an elongated body with one of each of the at least two separate components – at 12, positioned at the elongated body's opposite ends – see for example figures 1-2.

Referring to claims 5 and 15, Swenson discloses the at least two separate components have a composition strength that can withstand forces associated with fishing without breaking – see for example columns 1-2.

Referring to claim 6, Swenson discloses the elastic component – see figure 2, is a wire having a composition strength that can withstand forces associated with fishing and repetitive bending without breaking – see for example columns 1-2.

Referring to claims 8-9 and 12, Swenson discloses the elastic component – see the line in figure 2, has a biasing component – see for example figure 2, (the bending of 30 degrees is functional language).

Claims 1-6 and 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,393,757 to Bomann.

Referring to claims 1 and 11, Bomann discloses a fishing lure comprising, an elongated lure body – see figures 5-6, comprising at least first and second hard components/portions – at 72a-72n, 76 and 78, positioned at opposite ends of the elongated lure body, and a soft cover portion – at 32, wherein the soft portion houses the hard portion, and wherein the hard portion comprises at least two separate components joined by an elastic component – at 74, for allowing the lure body to flex – see for example figures 5-6.

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Referring to claims 2 and 13, Bomann discloses a fishing line attachment component – proximate 20, attached to one of the at least two separate components for allowing a fishing line to be connected to the lure body – see for example figures 5-6.

Referring to claims 3 and 14, Bomann discloses a hook attachment component – at 27b, attached to one of the at least two separate components for allowing a hook to be connected to the lure body– see for example figure 6.

Referring to claim 4, Bomann discloses the lure body is an elongated body with one of each of the at least two separate components – at 76 and 78, positioned at the elongated body's opposite ends – see for example figures 1-2.

Referring to claims 5 and 15, Bomann discloses the at least two separate components have a composition strength that can withstand forces associated with fishing without breaking – see for example columns 1-14.

Referring to claim 6, Bomann discloses the elastic component – at 74, is a wire having a composition strength that can withstand forces associated with fishing and repetitive bending without breaking – see for example figure 6 and columns 11-12.

Referring to claims 8-9 and 12, Bomann discloses the elastic component – at 74, has a biasing component, (the bending of 30 degrees is functional language) – see for example figure 6 and columns 11-12.

Referring to claim 10, Bomann discloses the soft portion – at 32, is made of plastic – see for example columns 7-8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson or Bomann as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 5,182,875 to Righetti.

Referring to claim 7, Swenson and Bomann do not disclose the elastic component is blade-shaped. Righetti does disclose the elastic component – at 900, is blade-shaped – see for example figure 11. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Swenson or Bomann and add the elastic component being blade-shaped of Righetti, so as to increase the flexibility of the lure so that it mimics the movements of fish.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson as applied to claim 1 above, and further in view of U.S. Patent No. 4,831,770 to Dworski. Swenson does not disclose the soft portion is plastic. Dworski does disclose the soft portion – at 12, is plastic – see for example column 2 lines 15-26. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Swenson and add the soft portion made of plastic, so as to make the lure flexible and more lightweight.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson or Bomann as applied to claim 11 above, and further in view of U.S. Patent No. 5,203,103 to

Hawley, Swenson and Bomann do not disclose the elastic component is a shape memory alloy. Hawley does disclose the elastic component – at 15, is a shape memory alloy – see for example columns 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Swenson or Bomann and add the elastic component being a shape memory alloy of Hawley, so as to allow for the lure to have flexibility while maintaining strength and durability.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to flexible fishing lures in general:

U.S. Pat. No. 941,911 to Burthe – shows flexible body

U.S. Pat. No. 1,393,617 to Frame – shows soft outer cover

U.S. Pat. No. 2,873,549 to Bartlett – shows soft outer cover

U.S. Pat. No. 3,344,550 to Peters – shows elastic component

U.S. Pat. No. 3,938,275 to Fukushima – shows bendable lure body

U.S. Pat. No. 3,965,606 to Bingler – shows soft outer cover

U.S. Pat. No. 4,211,027 to Viscardi – shows soft outer cover

U.S. Pat. No. 4,676,020 to Taylor et al. – shows hard components

U.S. Pat. No. 5,094,026 to Correll et al. – shows soft cover and hard components

U.S. Pat. No. 5,172,510 to Lovell, Jr. – shows soft outer cover

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U.S. Pat. No. 5,193,299 to Correll et al. – shows bendable lure body

U.S. Pat. No. 5,299,378 to Ballard – shows soft outer cover

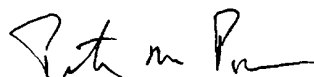
U.S. Pat. No. 5,894,693 to Davie – shows flexible outer cover

U.S. Pat. No. 6,546,663 to Signitzer et al. – shows flexible outer cover

U.S. Pat. No. 6,557,293 to Klapka – shows bendable lure body

9. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.



Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600

10/22/07